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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/675,252 | 09/29/2000 | Satoshi Washizuka | 1035-283 | 1246 |

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EXAMINER

PATEL, JAGDISH

ART UNIT PAPER NUMBER

3624

DATE MAILED: 07/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/675,252

Applicant(s)

WASHIZUKA ET AL.

Examiner

JAGDISH PATEL

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 4/6/05.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-17 and 19-28 is/are pending in the application.
- 4a) Of the above claim(s) 24-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-17 and 19-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| <p>1) <input type="checkbox"/> Notice of References Cited (PTO-892)</p> <p>2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)</p> <p>3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____</p> | <p>4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____</p> <p>5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)</p> <p>6) <input type="checkbox"/> Other: _____</p> |
|--|--|

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DETAILED ACTION

1. This communication is in response to amendment filed 4/6/05.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/6/05 has been entered.

Response to Amendment

3. Claims 6, 9-11, 13-14, 16-17 and 19-27 have been amended and new claim 28 has been added.

Response to Arguments

4. Applicant's arguments filed 4/6/05 have been fully considered but they are not persuasive. The applicant

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argues that the reconciliation unit (central controller 200) of Walker does not provide sellers with credit data that guarantees payment by the reconciliation unit for the products or services provided to the buyer (p.19). However, the examiner points out that this feature is clearly disclosed at col. 17, lines 27+ in relation to discussion of Figures 6 and 7. This is because the CPO is based on payment authorization as disclosed in this text. Therefore, it is asserted that the CPO created by the central controller constitute the electronic data that guarantees payment to the seller for the products requested by the buyer.

Election/Restrictions

5. Newly submitted claims 28 and amended claims 24-27 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: each of this claims recite a distinct feature of "short-distance communication circuitry"; "wide area communication circuitry" and processing system which communicates the seller terminal via the short-distance communication which are not present in the original claims.

Since applicant has received an action on the merits for the originally presented invention, this invention has

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been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 24-28 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections- 102

A person shall be entitled to a patent unless--

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States

Claims 2-15, 17, 19, 20, and 22-27 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Walker et al. (US 5,794,207) (Walker).

Claim 17 Walker-207 discloses an account reconciliation server (central controller 200, see Fig. 1 and 2), which guarantees account reconciliation in purchase transactions between a buyer and a seller of a product or service ,

said account reconciliation server comprising:

a communicating circuit means for establishing communications with each of a buyer terminal of the buyer and a seller terminal of the seller;

(Fig. 1 network interface 245)

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credit data creating means for creating, based on purchase request data received from the buyer terminal, credit data including information which specifies purchase transaction conditions for the product or service, and sending the credit data created to said seller terminal, said credit data guaranteeing account reconciliation for the product or service;

(CPU 205 and payment processor 230 connected to data storage device 250, see at least Fig. 2 and col.17 L 25-end);

delivery list creating means for creating and sending to said buyer terminal delivery list data relating to delivery of the product or service when the product or service is received from the seller;

(see at least Fig. 2 purchase confirmation database 275. and col. 13 L 39-43.. Purchase confirmation database 275 tracks the messages sent to the buyer and seller confirming completed transactions (bound contracts). Fields include buyer name, buyer ID number, seller name, seller ID number, purchase confirmation tracking number, and associated CPO tracking number.)

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claiming means which, when acceptance data for the delivery list data is received from the buyer terminal, causes the ' the product or service to be delivered to the buyer, and sends a claim to the buyer for payment for the product or service.

(see at least col. 17 L 27-47 .. at step 610, payment processor 230 submits a pre-authorization of the price of CPO 100 to the credit card clearinghouse.)

Claim 19: An account reconciliation server which guarantees account reconciliation in a purchase transaction between a buyer and a seller of a product or service,

said account reconciliation server comprising:

a communicating circuit means for establishing communications with each of a buyer terminal for the buyer and a seller terminal for the seller;

(see claim 17 analysis)

credit data creating means for creating, based on purchase request data for the product or service supplied from the buyer terminal credit data including information which specifies purchase transaction conditions for the product or service , and sending the credit data to said

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seller terminal means, said credit data guaranteeing payment to the seller for the supplying of the product or service; (see at least col. 17 L 27-47 .. at step 610, payment processor 230 submits a pre-authorization of the price of CPO 100 to the credit card clearinghouse.)

and

claiming means for, when acknowledgement data from the buyer terminal is received via said seller terminal, sending payment data to said seller terminal for the product or service, while billing the buyer for the payment for the product or service , said acknowledgement data being issued by said buyer terminal when the buyer receives from the seller the product or service which is based on content of the credit data and when the content satisfies the purchase transaction conditions in the credit data.

(col. 9 L 31-44 Escrow account 299 allows payment to be delayed until the seller completes delivery of the goods, while at the same time ensuring that the buyer will in fact make payment. Central controller 200 establishes escrow account 299 as a temporary holding account. When the seller binds CPO 100 at step 1110, funds are transferred

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from buyer account 297 to escrow account 299. Only after the goods have been received by the buyer are funds transferred from escrow account 299 to seller account 298.)

Claim 20: An accounting and reconciliation system comprising:

a seller terminal for a seller, the seller terminal receiving credit data guaranteeing payment for a product or service, and receiving payment data for the product or service;

(Fig. 3 seller interface 300, modem 350)

a buyer terminal for a buyer, the buyer terminal sending purchase request data including purchase transaction information which specifies purchase transaction conditions for the product or service;

(Fig. 4 buyer interface 400, modem 450)

a reconciliation unit for mediating a purchase transaction between the buyer and the seller in response to receiving the purchase request data sent from the buyer terminal, (see Fig. 2 central controller) the reconciliation unit comprising:

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communication circuitry for communicating with the
buyer terminal and the seller terminal;

(network interface 245) and

a processing system responsive to the purchase request
data for sending the credit data to the seller terminal,
and for sending the payment data to the seller terminal
after receiving

acknowledgment data indicative of the buyer's
acknowledgment of receipt of the product or service.

(Figures 2 and 6, col. 9 L 32-44, see col. 22 "delayed
payment embodiments)

Claim 2: The accounting and reconciliation system as
set forth in claim 20, wherein:

said seller terminal includes an input device
usable by the seller to input an estimate in response to an
estimate request from the buyer for a product or service to
be supplied,

(see Fig. 3 input device 345 see also corresponding
description)

said seller terminal creates estimate data based on
the
estimate and sends the estimate data to said buyer
terminal, and

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(col. 19 L 55-59)

said buyer terminal receives the estimate data and creates the purchase request data based on the received estimate data.

(col. 19 L 55-59)

Claim 3: The accounting and reconciliation system as set forth in claim 2 wherein:

said buyer terminal includes a display for displaying content of the received estimate data, and an input device usable the buyer to accept the content of the displayed estimate data, and

said buyer terminal creates the purchase request data upon acceptance of the content of the estimate data.

(col. 19 L 55-59, display device is inherent to the online access by the buyer described at col. 15 L 45+)

Claim 4: The accounting and reconciliation system as set forth in claim 3, wherein:

the estimate data contains information which specifies first and second payment methods, and

said buyer terminal prompts the buyer via said display to confirm that the second payment method may be used if the first

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payment method fails.

Claim 5: The accounting and reconciliation system as set forth in claim 20, wherein:

said buyer terminal includes an input device usable by the buyer to input information which relates to one or more of an effective period of the purchase request data, delivery date of the product or service services, delivery method of the product or service, possibility of separate delivery, and due date of payment from a bank, and

said buyer terminal incorporates the input information in the purchase request data.

(col. 17 L 36-41, col. 16 L 46 "expiration date" to the CPO)

Claim 15: The accounting and reconciliation system wherein the buyer terminal comprises a cellular phone.

(see col. 11 L 61+ Connection may also be provided by dedicated data lines, **cellular**, Personal Communication Systems ("PCS"), microwave, or satellite networks)

Claim 21: Walker discloses an accounting and reconciliation system comprising:

a seller terminal for a seller, the seller terminal receiving credit data guaranteeing payment for a product or

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service, and receiving payment data for the product or service;

(Figure 3 seller interface, and Figures 9 and 11)

a buyer terminal for a buyer, the buyer terminal sending purchase request data including purchase transaction information which specifies purchase transaction conditions for the product or service, receiving delivery list data relating to delivery of the product or service, and sending acceptance data in response to the delivery list data;

(Figure 4 Buyer interface, Figures 5 and 13)

and

a reconciliation unit for mediating a purchase transaction between the buyer and the seller in response to receiving the purchase request data sent from the buyer terminal to the reconciliation unit, the reconciliation unit comprising: communication circuitry for communicating with the buyer terminal and the seller terminal;

(Fig. 2, central controller 200, and process performed by the central controller as shown in Figures 6-8, refer also to the appropriate sections of the Detailed Description)

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a processing system responsive to the purchase request data for sending the credit data to the seller terminal and for sending the payment data to the seller terminal after the product or service is supplied from the seller.

(Figure 11 and col. 19 L 61- col. 20 L 4)

wherein the credit data guarantees payment to the seller by the reconciliation unit for the product or service

(although, this recitation is treated as non-functional data structure or intended use of the credit data without altering the structure of the claim, Walker teaches this as CPO which guarantees payment to seller by the central controller).

Claims 22-23 are apparatus claims, which recite structure of an apparatus (such as claim 22 recites structure of a reconciliation unit). Examination of the apparatus claims is based upon and supported by the following guidelines (see applicable section of MPEP).

Apparatus and Article Claims – Functional Language
For a discussion of case law which provides guidance in interpreting the functional portion of means-plus-function limitations see MPEP § 2181 - § 2186.

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APPARATUS CLAIMS MUST BE STRUCTURALLY DISTINGUISHABLE
FROM THE PRIOR ART

While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. [In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) (The absence of a disclosure in a prior art reference relating to function did not defeat the Board's finding of anticipation of claimed apparatus because the limitations at issue were found to be inherent in the prior art reference); see also In re Swinehart, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971);< In re Danly, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). "[A]pparatus claims cover what a device is, not what a device does." Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original)].

MANNER OF OPERATING THE DEVICE DOES NOT DIFFERENTIATE
APPARATUS CLAIM FROM THE PRIOR ART

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be

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employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural imitations of the claim. Ex parte Masham, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987) (The preamble of claim 1 recited that the apparatus was "for mixing flowing developer material" and the body of the claim recited "means for mixing ..., said mixing means being stationary and completely submerged in the developer material". The claim was rejected over a reference which taught all the structural limitations of the claim for the intended use of mixing flowing developer. However, the mixer was only partially submerged in the developer material. The Board held that the amount of submersion is immaterial to the structure of the mixer and thus the claim was properly rejected.

The following analysis of claims 22-23 is based upon the foregoing examination guidelines for an apparatus. The limitation(s) shown in the brackets are treated as intended use or non functional limitations].

Per Claim 22 Walker disclose a reconciliation unit [for an accounting and reconciliation system comprising a seller terminal for a seller, the seller terminal receiving credit data guaranteeing payment for a product or service,

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and receiving payment data for the product or service, and a buyer terminal for a buyer, the buyer terminal sending purchase request data containing purchase transaction information which specifies purchase transaction conditions for the product or service, wherein the reconciliation unit mediates a purchase transaction between the buyer and the seller in response to receiving the purchase request data sent from the buyer terminal,) the reconciliation unit (see Figure 2, central controller 200) comprising:

communication circuitry for communicating with the buyer terminal and the seller terminal; (Figure 2, network interface 245)

and

a processing system responsive to the purchase request data for sending the credit data to the seller terminal and for sending the payment data to the seller terminal after receiving acknowledgment data indicative of the buyer's acknowledgement of receipt of the product or service.

(Figure 2, CPU 205, payment processor 230 and data storage device 250 connected to buyer and seller terminals; also refer to Figure 11 and col. 19 L 60+)

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wherein the credit data guarantees payment to the seller by the reconciliation unit for the product or service

(although, this recitation is treated as non-functional data structure or intended use of the credit data without altering the structure of the claim, Walker teaches this as CPO which guarantees payment to seller by the central controller).

Claim 23: walker discloses a reconciliation unit (see Figure 2, central controller 200) for an accounting and reconciliation system comprising a seller terminal for a seller, the seller terminal receiving credit data guaranteeing payment for a product or service, and receiving payment data for the product or service, and a buyer terminal for a buyer, the buyer terminal sending purchase request data including purchase transaction information which specifies purchase transaction conditions for the product or service, receiving delivery list data relating to delivery of the product or service, and sending acceptance data in response to the delivery list data, wherein the reconciliation unit mediates a purchase transaction between the buyer and the seller in response to

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receiving the purchase request data sent from the buyer terminal, the reconciliation unit comprising:

communication circuitry for communicating with the buyer terminal and the seller terminal; (Figure 2, network interface 245)

and

a processing system responsive to the purchase request data for sending the credit data to the seller terminal, and for sending the payment data to the seller terminal after the product or service is supplied from the seller.

(Figure 2, CPU 205, payment processor 230 and data storage device 250 connected to buyer and seller terminals; also refer to Figure 11 and col. 19 L 60+)

wherein the credit data guarantees payment to the seller by the reconciliation unit for the product or service

(although, this recitation is treated as non-functional data structure or intended use of the credit data without altering the structure of the claim, Walker teaches this as CPO which guarantees payment to seller by the central controller).

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Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAGDISH PATEL whose telephone number is (571) 272-6748.

The examiner can normally be reached on 800AM-600PM M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (571)272-6747. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jagdish N. Patel 
(Primary Examiner, AU 3624)

6/27/05